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programming offered to said set-top terminal over said cable network through the specified in-band channel such that said first processor can maintain said user interface including user services while said second processor manages the download.

### REMARKS

Reconsideration and allowance are respectfully requested. Claims 1-42 are currently pending and stand rejected by the Examiner. Applicants have amended claim 41. No new matter has been added.

#### § 103 rejections

Claims 1-4, 7-17, 21-22, 24-27, 30-36, 39, 40 and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,666,293 to Metz et al. ("Metz-293") in view of U.S. Patent No. 5,978,855 to Metz et al. ("Metz-855") and further in view of U.S. Patent No. 5,784,095 to Robbins et al. ("Robbins"). Applicants respectfully traverse this rejection. Applicants note that claim 18 was not explicitly rejected, but was included in the Examiner's comments in the rejection of this claim group. Applicants therefore will assume that claim 18 was meant to be rejected and respectfully request immediate clarification by the Examiner if this is not the case.

The Office Action admitted that Metz-293 does not specifically disclose a terminal that is informed by a head-end of a specified in-band channel on which downloadable data is offered, but asserted that Metz-855 discloses instructing the set-top terminal to change to another channel and receive an application download (p. 3). The Office Action also admitted that Metz-293 and Metz-855 do not disclose using an out-of-band control channel to monitor download information, but asserted that Metz-855 discloses downloading data via an in-band channel and that Robbins discloses the use of out-of-band control and program data in the claimed manner (p. 4). Applicants respectfully disagree.

Neither Metz-293 nor Metz-855 suggests using an out-of-band channel to monitor the availability of in-band channel downloads. Metz-293 only teaches storing a network program channel that will carry operating system software in non-volatile memory, but does not mention anything about an out-of-band channel (col. 8, lines 26-31). Additionally, as admitted by the Office Action, Metz-293 does not teach

receiving a signal from a headend regarding a specified in-band channel on which a download is available.

Metz-855 also fails to teach or suggest the claimed monitoring the out-of-band control channel. Metz-855 only teaches allowing a user to select a video information provider (VIP) and establish a text session between the set-top terminal and the text server of the VIP choice by selecting a broadcast channel having a related text service. The text server can then instruct the set-top terminal to initiate downloading over the selected broadcast channel (col. 11, lines 11-32). In other words, Metz-855 teaches using an in-band channel both for indicating the specified channel receiving the download and for the download operation itself, without any involvement from the out-of-band channel.

The Office Action also asserted that Metz-293 includes "criteria tending to indicate that acceptance of the download will cause a minimum of interference with the subscriber's use of the set-top terminal" (p. 3). Applicants respectfully note that Metz-293 does not suggest the claimed criteria because col. 9, lines 20-37 only discuss alternative procedures for on-screen displays during the upgrade procedure. If the user manually initiates the download procedure, the digital entertainment terminal (DET) displays a "Please Wait" message. If the DET is turned off, no message will be displayed. Nothing in Metz-293 indicates that interference with the subscriber's use of the set-top terminal is a concern, or even sets forth any criteria to be satisfied before downloading; instead, Metz-293 simply states that no message will be displayed during downloading if the DET is turned off. Metz-293 allows downloading to occur without ever evaluating or even addressing whether the download will interfere with the use of the set-top terminal. Thus, rather than "tending to indicate" the claimed criteria, Metz-293 downloads without reference to any criteria at all.

Further, as noted in Applicants' May 14, 2001 Preliminary Amendment, it would not have been obvious to incorporate an out-of-band control channel, such as the out-of-band channel mentioned in Robbins, in the Metz-293/Metz-855 combination because Metz-855 assumes that the download indication information and the downloadable data itself will be transmitted via the same, in-band, user-selected channel (col. 11, lines 12-15 and lines 22-27). One of ordinary skill in the art would have focused on improving the manner in which information is transmitted via the in-

band channels and would not have incorporated an out-of-band channel like the claimed invention. Thus, neither Metz-293 or Metz-855, either alone or in combination, suggests adding the Robbins reference as proposed by the Office Action to show the claimed out-of-band channel monitoring function.

Because there is no motivation to combine the references and because none of the references, either alone or in combination, suggest downloading according to predetermined criteria, the Office Action fails to establish a prima facie case of obviousness with respect to claims 1-4, 7-18, 21-22, 24-27, 30-36, 39, 40 and 42. Withdrawal of the rejection is respectfully requested.

Claims 5 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Metz-293 in view of Metz-855 and further in view of Robbins and U.S. Patent No. 5,373,557 to Diehl et al. ("Diehl"). Applicants respectfully traverse this rejection. Claims 5 and 28 depend on independent claims 1 and 24, respectively, and therefore the Office Action fails to establish a prima facie case of obviousness for the reasons explained above. Adding Diehl to the Metz-293/Metz-855/Robbins combination still would not have suggested the claimed invention because Diehl only describes time of day criteria and does not overcome the deficiencies described above. Withdrawal of the rejection is therefore respectfully requested.

Claims 6, 19, 29 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Metz-293 in view of Metz-855 and further in view of Robbins and U.S. Patent No. 5,640,484 to Mankovitz ("Mankovitz"). Applicants respectfully traverse this rejection. Claims 6, 19, 29 and 37 depend on claims 1, 18, 27 and 36, respectively, and therefore the Office Action fails to establish a prima facie case of obviousness for the reasons explained above. It would not have been obvious to combine Mankovitz with Metz-293/Metz-855/Robbins because, as explained above, the combination does not even suggest predetermined criteria of any kind, let alone the criteria suggested in Mankovitz. Withdrawal of the rejection is therefore respectfully requested.

Claims 20 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Metz-293 in view of Metz-855 and further in view of Robbins and U.S. Patent No. 5,987,210 to Iggulden et al. ("Iggulden"). Applicants respectfully traverse this rejection. Claims 20 and 38 depend on claims 18 and 36, respectively, and therefore the Office Action fails to establish a prima facie case of obviousness for

the reasons explained above. It would not have been obvious to combine Iggulden with Metz-293/Metz-855/Robbins because, as explained above, the combination does not even suggest predetermined criteria of any kind, let alone the criteria suggested in Iggulden. Withdrawal of the rejection is therefore respectfully requested.

Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Metz-293 in view of Metz-855 and further in view of Robbins and U.S. Patent No. 5,619,250 to McClellan et al. ("McClellan"). Applicants respectfully traverse this rejection. Claim 23 depends on claim 18, and therefore the Office Action fails to establish a prima facie case of obviousness for the reasons explained above. McClellan focuses only on requesting permission to reset a set-top box and does not address the deficiencies noted above with respect to the other references. Withdrawal of the rejection is therefore respectfully requested.

Claim 41 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Metz-293 in view of U.S. Patent No. 5,909,559 to So ("So"). Applicants respectfully traverse this rejection. Applicants have amended claim 41 to recite monitoring an out-of-band channel for information indicating that a download is available, indicating a specified in-band channel for receiving the download, and managing the download. The Office Action therefore fails to establish a prima facie case of obviousness with respect to claim 41 for the reasons explained above, and withdrawal of the rejection is respectfully requested.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is earnestly solicited.

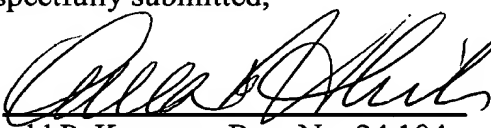
Any fees associated with the filing of this paper should be identified in any accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC.

Respectfully submitted,

Dated:

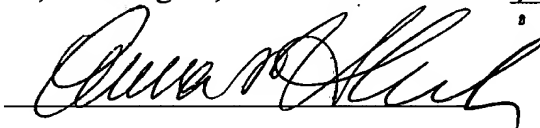
14 November 2001

By

  
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CERTIFICATE OF MAILING

I hereby certify that the enclosed Amendment is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on this 14 day of November, 2001.





41. (Once amended) A set-top terminal for connecting a subscriber to a cable network, said terminal comprising:

a processor unit comprising a first processor and a second processor; and  
a memory unit;

wherein, said first processor is dedicated to providing a user interface and said second processor is dedicated to monitoring an out-of-band channel for information indicating that a download of data or programming is available, indicating a specified in-band channel for receiving the download, and managing a download of data or programming offered to said set-top terminal over said cable network through the specified in-band channel; such that said first processor can maintain said user interface including user services while said second processor manages athe-download.

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